

REMARKS

Claims 1, 2, 13, 14, 20, 21 and 26 to 31 are the only currently active claims pending in this application. Claims 32 and 33 are canceled. The foregoing separate sheets marked as "Listing of Claims" show all the claims in the application, each with an indication at its first line showing its current status. Applicants respectfully maintain their traverse of the restriction requirement as to claim 3-12, 15-19, 22 to 25, and preserve their right to petition the Director pursuant to 37 C.F.R. §§ 1.144 and 1.181.

Rejections Not Based on Prior Art

Applicants respectfully respond to the Office Action's rejections of claims 1, 13, 20 and 30, under 35 U.S.C. § 112, second paragraph, in the order they appear in the Office Action.

Responding to the rejection of claims 1, 13, 20 and 30 at paragraph 6 of the Office Action, Applicants respectfully submit that the phrase "second information providing means" is deleted from claim 1 by the amendment above. *See* claim 1 (currently amended), at line 22. Applicants therefore respectfully request that this rejection be reconsidered and withdrawn.

Responding to the rejection of claims 1, 13 and 20 at paragraph 7 of the Office Action, Applicants respectfully submit that all recitals of "in case of," and of all other phrases identified by the Office Action as the bases for the rejection, are deleted or otherwise amended to clearly meet all requirements of 35 U.S.C. § 112, second paragraph, by the amendments above. *See* claim 1 (currently amended), at lines 21-31; claim 13 (currently amended), at lines 14-27; and claim 20 (currently amended), at lines 22-34. Applicants therefore respectfully request that these rejections be reconsidered and withdrawn.

Responding to the rejection of claims 30 at paragraph 8 of the Office Action, Applicants respectfully submit that all language identified by the Office Action is deleted or otherwise amended to clearly meet all requirements of 35 U.S.C. § 112, second

paragraph, by the amendments above. *See* claim 30 (currently amended), at lines 5-6. Applicants therefore respectfully request that this rejection be reconsidered and withdrawn.

Rejections Based on Prior Art

The Office Action rejects claims 1, 2, 13, 14, 20, 21, and 26-28 under 35 U.S.C. §102(a) as being anticipated by U.S. Patent 6,061,719 (“Bendinelli”). *See* Office Action at paragraph 9. Applicants respectfully note the Office Action’s “disclaimer,” that qualifies the rejection as being based on the claims as they were understood by the Examiner prior to the amendments above for better definiteness under 35 U.S.C. § 112, second paragraph. Applicants respectfully request that the Examiner reconsider these rejections in view of the currently amended claims, and withdraw these rejections, because Bendinelli lacks multiple limitations of each of the amended claims 1, 2, 13, 14, 20, 21, and 26-28, and therefore cannot anticipate any of these claims under 35 U.S.C. §102(a).

Claim 1

Applicants’ claim 1 recites, in combination with other limitations, “a means for storing a customer information data representing attributes of a customer.” Claim 1 (currently amended), at lines 3-4. Bendinelli does not teach, disclose or suggest any structure, or acts, that perform or carry out the function defined by this element. Bendinelli discloses URLs embedded in a television signal and synchronizing presentation of the non-URL television signal with the web content corresponding to that URL, via a set-top box 34, a computer display 56, or a picture-in-picture (PIP) arrangement with the television picture. *See* Bendinelli at Figs. 1-4. None of these components, or any other components or functions described by Bendinelli, the “server” 42 have or store anything within the broadest reasonable meaning of the claim 1 “customer information data representing attributes of a customer.”

Claim 1 recites “means for generating a customer-specific advertisement data based, at least in part, on said customer information data and said first information, and

including a communication address corresponding to said customer.” Claim 1 (currently amended), at lines 7-9. Bendinelli does not teach or suggest storage of “customer information data representing attributes of a customer,” and does not teach or suggest generation of a “customer-specific advertisement data based” in any part, on such “customer information data.” As stated above, Bendinelli discloses URLs embedded in a television signal and synchronizes presentation of web content corresponding to that URL to the presentation of the non-URL video in the television signal.

Claim 1 recites “an information receiving terminal constructed and arranged to receive said first information data and said customer-specific advertisement data.” Claim 1 (currently amended), at lines 17-19. Bendinelli does not, and cannot teach, disclose or suggest anything of a receiver or terminal so constructed and arranged because that reference does not have a “customer information data,” or a “customer-specific advertisement data based” on such data.

Applicants, for the foregoing reasons, respectfully request that this rejection of claim 1 be reconsidered and withdrawn.

Claim 2

Applicants’ claim 2 recites, in combination with other limitations, “a second information providing means having means for storing a customer information data representing attributes of a customer.” Claim 2 (currently amended), at lines 5-6. As Applicants have stated above, Bendinelli does not teach, disclose or suggest anything within the broadest reasonable meaning of “storing a customer information data representing attributes of a customer.”

Claim 2 recites a “means for generating and transmitting . . . a customer-specific advertisement data . . . based, at least in part, on said customer information.” Claim 2 (currently amended), at lines 8-11. Bendinelli does not teach, disclose or suggest anything within the broadest reasonable meaning of the function defined by this claim 2 “generating and transmitting” element.

Claim 2 recites, in combination with its other recited elements, “an information receiving terminal accessible by said customer, constructed and arranged to receive said first information data via said first information transfer path and said customer-specific advertisement data.” Claim 2 (currently amended), at lines 12-15.

Bendinelli does not, and cannot teach, disclose or suggest anything of a receiver or terminal so constructed and arranged because that it does not store a “customer information data,” or a “customer-specific advertisement data based” on such data.

Applicants, for the foregoing reasons respectfully request that the rejection of claim 2 be reconsidered and withdrawn.

Claim 13

Applicants’ claim 13 recites a method having, in combination with other limitations, “storing a customer information data representing attributes of a customer.” Claim 13 (currently amended), at line 2. Bendinelli lacks this element. Bendinelli discloses URLs embedded in a television signal, and synchronizing presentation of the non-URL television signal with the web content corresponding to that URL, via a set-top box 34, a computer display 56, or a picture-in-picture (PIP) arrangement with the television picture. *See* Bendinelli at Figs. 1-4. None of these structures, or any other components or functions described by Bendinelli, are within the broadest reasonable meaning of this claim 13 element of “storing a customer information data representing attributes of a customer.”

Applicants’ claim 13 recites, in combination with other limitations, “transmitting an advertisement data … and a customer-specific advertisement data based on said advertisement data and said customer data.” Claim 13 (currently amended), at lines 5-6. Bendinelli does not teach, disclose or suggest anything within the broadest reasonable meaning of this “transmitting” element.

Applicants’ claim 13 recites “receiving said advertisement data and said customer-specific advertisement data.” Claim 13 (currently amended), at lines 9-10.

Bendinelli does not teach, disclose or suggest anything of this “receiving” element because Bendinelli does not store a “customer information data,” and does not generate the claim’s “customer-specific advertisement data” based on this customer data.

Applicants, for the foregoing reasons, respectfully request that the rejection of claim 13 be reconsidered and withdrawn.

Claim 14

Applicants’ claim 14 recites a method having, in combination with other limitations, “storing a customer information data representing attributes of a customer.” Claim 14 (currently amended), at line 2. Bendinelli lacks this element. Bendinelli discloses URLs embedded in a television signal, and synchronizing presentation of the non-URL television signal with the web content corresponding to that URL, via a set-top box 34, a computer display 56, or a picture-in-picture (PIP) arrangement with the television picture. *See* Bendinelli at Figs. 1-4. None of these structures, or any other components or functions described by Bendinelli, are within the broadest reasonable meaning of this claim 13 element of “storing a customer information data representing attributes of a customer.”

Applicants’ claim 14 recites, in combination with other limitations, “generating a customer-specific advertisement data based, at least in part, on said customer data.” Claim 14 (currently amended), at lines 6-7. Bendinelli does not teach, disclose or suggest anything within the broadest reasonable meaning of this “generating” element.

Applicants’ claim 14 recites the element of “transmitting said customer-specific advertisement data.” Claim 14 (currently amended), at line 9. Bendinelli does not teach, disclose or suggest anything within the broadest reasonable meaning of this “transmitting” element, because the reference’s disclosed apparatus and method does not store “customer information,” and does not generate the claim’s “customer-specific advertisement,” and a reference cannot teach transmitting specific data that it does not disclose.

Applicants' claim 14 recites that element of "receiving, at said receiving terminal ... said customer-specific advertisement data receiving said advertisement data and said customer-specific advertisement data." Claim 14 (currently amended), at lines 13-15. Bendinelli does not teach, disclose or suggest anything of this "receiving" element because Bendinelli does not store a "customer information data," does not generate or transmit the claim's "customer-specific advertisement data" based on this customer data and, therefore, cannot teach receiving subject matter that it does not disclose.

Applicants, for the foregoing reasons, respectfully request that the rejection of claim 14 be reconsidered and withdrawn.

Claims 20 and 21

Applicants' claims 20 and 21 are Beauregard claims to a machine-readable medium and instructions stored on same for instructing a machine to perform the method of claims 13 and 14, respectively. Applicants therefore respectfully submit that since Bendinelli lacks multiple elements of each of claims 13 and 14, it cannot anticipate of claims 20 or 21, for substantially the same reasons as presented above.

Applicants therefore respectfully request that the rejection of claims 20 and 21 be reconsidered and withdrawn.

Claims 26 and 27

Applicants respectfully submit that claims 26 and 27 are each dependent, or ultimately dependent, on base claim 2, and are therefore combination claims having, in addition to their own limitations, all of the limitations of claim 2. Therefore, both of these claims are patentable over Bendinelli, for at least the reasons Applicants have shown for claim 2 above.

Claim 28

Applicants respectfully submit that claims 28 is dependent on claim 2, and therefore is a combination claim having, in addition to its own limitations, all of the limitations of its base claim 2. Claim 28 is therefore patentable over Bendinelli, for at least the reasons Applicants have shown for its base claim 2 above.

Further, for the record, Applicants respectfully submit that the Office Action's statement at paragraph 13 misreads or misinterprets the subject matter disclosed by Bendinelli. Bendinelli does not teach, disclose or suggest an "information providing system , wherein [transmission of] said second information ... is in response to an input by said customer." Applicants respectfully note that the quoted language cited by the Examiner in this rejection has been amended by the amendment above to more particularly claim the supporting subject matter disclosed by Applicants' specification and figures. Claim 28, as currently amended, recites:

means for said customer to send a response request for said customer-specific advertisement data to said second information providing means, and wherein said means for generating and transmitting said customer-specific advertisement data transmits said customer-specific advertisement data in response to receiving said response request

Claim 28 (currently amended), at lines 2-7.

Bendinelli does not teach or suggest the above-recited functions of this "means for said customer to send a response request," or this claim's additional recited function of the base claim 2 "means for generating and transmitting said customer-specific advertisement," because Bendinelli does not teach or disclose anything within the meaning of the base claim 2 limitations of storing "customer information data," or of generating, transmitting, or receiving a "customer-specific advertisement," based on such data.

Applicants therefore respectfully request reconsideration and withdrawal of this rejection, both for the reasons set forth for its base claim 2 and the additional reasons set forth above.

Claim 31

The Office Action rejects claim 31 under 35 U.S.C. §102(a) as being anticipated by Bendinelli. *See* Office Action at paragraph 14. Applicants respectfully submit that Bendinelli lacks multiple limitations of claim 31 and, therefore, cannot anticipate the claim.

First, Applicants respectfully submit that claims 31 is dependent on claim 2, and therefore is a combination claim having, in addition to its own limitations, all of the limitations of its base claim 2. Therefore, claim 31 is patentable over Bendinelli, for at least the reasons Applicants have shown for claim 2 above.

Further, for the record, Applicants respectfully submit that the Office Action's statement at paragraph 14 misreads or misinterprets the subject matter disclosed by Bendinelli. Applicants respectfully note that the claim 31 language cited by the Examiner in this rejection at paragraph 14 has been amended by the amendment above to more particularly claim the supporting subject matter disclosed by Applicants' specification and figures. Claim 31, as currently amended, recites:

means for said customer to send a viewing response data identifying receipt of said advertisement data;

means for collecting a database of said viewing response data; and

means for analyzing said viewing response data to generate an evaluation data representing statistics of customer viewing of said pre-determined advertisement

Claim 31 (currently amended), at lines 3-12.

Example support for the above-quoted language is disclosed by Applicants' specification, at page 46, line 24, through page 47, line 21, and page 53, line 16, through page 54, line 3.

Bendinelli does not teach or suggest any of the above-recited functions of the claim 31 "means for collecting a database," or its "means for analyzing" elements.

The Bendinelli subject matter that Office Action cites as disclosing "analyz[es] that the user decided to view a given advertisement by selecting the option for continuous display" is not, upon reading the entire Bendinelli patent, within the broadest reasonable meaning of the claim 31 elements of "collecting a database" or "generat[ing] an evaluation data representing statistics of customer viewing of said predetermined advertisement."

Applicants therefore respectfully request reconsideration and withdrawal of this rejection of claim 31, both for the reasons set forth for its base claim 2 and the additional reasons set forth above.

Claims 29-33

The Office Action rejects claims 29-33 as being unpatentable over Bendinelli in view of U.S. Patent No. 6,446,130 (“Grapes”). *See* Office Action, at paragraphs 15-18. Applicants believe that the Office Action intended to state a rejection of claims 29-30 and 32-33 over Bendinelli and Grapes, but not of claim 31, because it rejected claim 31 as anticipated by Bendinelli and does not mention claim 31 in the Section 103 rejections set forth in its paragraphs 15 – 18. Claims 32 and 33 are canceled. Applicants therefore respond only to the Section 103 rejections of pending claims 29 and 30. Applicants respectfully request, however, that if claim 31 was indeed rejected by the Office Action as being unpatentable over the combination of Bendinelli and Grapes, notwithstanding the Office Action not stating any basis or reasoning for that rejection, that Applicants be given an opportunity to respond without being unfairly constrained by PTO after-final examination procedure.

Claim 29

Claim 29 recites:

means for said customer to send a response request, via said second transfer path, for said customer-specific advertisement data to said second information providing means, and for including with said response request a data identifying said customer and identifying said pre-determined advertisement; and

evaluation means for sending a reward data to said customer based, at least in part, on said customer sending said response request

Claim 29 (currently amended), at lines 3-10

Bendinelli does not teach or suggest the above-recited function of this claim 29 “means for said customer to send a response request for said customer-specific advertisement data” because Bendinelli does not teach or disclose anything within the meaning of the base claim 2 limitations of storing “customer information data,” or of

generating, transmitting, or receiving a “customer-specific advertisement,” based on such data.

Applicants respectfully submit that the subject matter the Office Action references in Grape does not provide the teaching or suggestions necessary to motivate a person of ordinary skill in the art to combine and/or modify the aggregate disclosures of Bendinelli and achieve either the limitations of claim 29.

The Office Action cites Grapes, at column 8, lines 13-16, but Applicants respectfully submit that said passage has nothing to do with claim 29. Applicants submit that Grapes at column 8, lines 9-12, discloses a printer for printing hard copies of promotional material. This is not a disclosure of the “promotional material” being directed to a specific customer, and not a disclosure of the “promotional material” being based on the user interaction with the system, much less on the user sending a “request for said customer-specific advertising.”

The Office Action cites Grapes, at column 9, lines 1-14, which discloses monitoring “purchases made by users … and user interactivity … that may be used to provide content advertisers and content providers with more location specific information.” None of these functions or acts, however, is, teaches, discloses or otherwise suggests the claim 29 limitation of sending a “reward data to said customer.”

The Office Action cites Grapes at column 14, lines 41-44 and 51-53 which discloses the system as requiring the user to send user-specific information *after* the user requests additional information, which is directly opposite of the base claim 1 means for storing customer information and sending a customer-specific advertisement based on the stored information, and discloses a printed hard copy of the transaction. A printer hard copy is not within the broadest reasonable meaning of the claim 29 function of “sending a reward data to the customer.”

The Office Action cites Grapes column 15, lines 14-18, which recites that “[p]roducts or services may be ordered … and *such transactions can supply* the user with goods, coupons, or services *directly*, such as providing the user with a redemption coupon

or an entertainment multimedia track that is available on the system.” *Id.* Applicants respectfully submit that the cited passage of Grapes discloses a system through which a user can order goods and services, and which can directly provide the user with the goods and services (such as multimedia track) if they are downloadable, and coupons, because coupons are printable. Grapes, however, teaches nothing of these goods or services being delivered to the user, or coupons printed by the user, as a *reward* for the user using the system. Grapes, including the passages cited by the Office Action, discloses nothing more than a system through which a user order goods and services and, if those goods or services are electronic they can be downloaded and, if printable (such as coupons ordered by the user) they can be printed by the user. Applicants respectfully submit that this is not a disclosure of the claim 29 function of sending a reward to the user, for any reason, much less in response to the user sending a request for the base claim 2 “customer-specific advertisement.”

Applicants therefore respectfully request reconsideration and withdrawal of this rejection of claim 29.

Claim 30

The Office Action states, at its paragraph 16, its bases for rejecting claim 30 as unpatentable over Bendinelli in view of Grapes.

Applicants first respond that claim 30 is dependent from claim 29, which, in turn, depends from base claim 2. Claim 30 is therefore a combination claim having, in addition to its own limitations, all of the limitations of intervening claim 29 and base claim 2. Applicants therefore respectfully submit that all these claims are patentable over Bendinelli and Grapes, for at least the reasons Applicants have shown for claim 2 (with respect to Bendinelli) and 29 above.

Applicants further submit that claim 30 recites:

“said means for said customer to send a response request includes means for said customer to select and send one or more from among a plurality of different values of response requests, said values representing a corresponding plurality of different kinds of commercial transactions, and

said evaluation means sends said reward data further based on the value of said response request

Claim 30 (currently amended), at lines 2-9.

As stated above with respect to claim 29, Grapes discloses nothing more than a system through which a user orders goods and services and, if those goods or services are electronic they can be downloaded and, if printable (such as coupons ordered by the user) they can be printed by the user. As Applicants respectfully submitted above, this is not a disclosure of the claim 29 function of sending a reward to the user, for any reason, much less in response to the user sending a request for the base claim 2 “customer-specific advertisement.”

The Office Action cites Grapes at column 3, lines 41-48 and 56-65, and at column 15, lines 14-18, as a teaching or suggestion for modifying “Bendinelli to include evaluation means ... for rewarding said customer responding to a contribution degree ... by offering incentives at the time of purchase.” Office Action at paragraph 16, lines 15 - 21.

Applicants respectfully submit that claim 30, as amended above, more clearly points out and claims novel subject matter disclosed by Applicants originally filed specification.

Applicants respectfully submit that the subject matter described by Grapes at column 3, lines 41-48, is not within the broadest reasonable meaning of the amended claim 30 limitations; the cited subject matter described by Grapes actually has nothing to do with Applicants’ invention, either as claimed by claim 30, by intervening claim 29, or by base claim 2. The cited subject matter described by Grapes is a printer for printing hard copies of promotional materials requested by the user. This subject matter is not relevant to, and does not teach or suggest, the printer receiving or printing anything as a reward to the user for using the system, or for the user sending a request for a “customer-specific” advertisement, or the printer receiving or printing anything that is reward, having a type or kind, related to the type or kind of response the user has sent.

Docket 01750027AA
Serial No.: 09/899,206

Applicants therefore respectfully request reconsideration and withdrawal of this rejection of claim 30, for the reasons set forth for its base claim 2 and intervening claim 29, and the additional reasons set forth above.

In view of the foregoing, it is requested that the application be reconsidered, that claims 1, 2, 13, 14, 20, 21 and 26 to 31 be allowed and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 703-787-9400 (fax: 703-787-7557; email: mike@wcc-ip.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

If any further extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such additional extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



Michael E. Whitham
Reg. No. 32,635

Whitham, Curtis, Christofferson and Cook, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190
703-787-9400
703-787-7557 (fax)

Customer Number 30743